

## **REMARKS**

### **I. PRELIMINARY REMARKS**

Claims 44 and 46 have been amended. Claims 148-154 have been added. Claims 45 and 51-114 have been canceled. Claims 44, 46-50 and 148-154 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant indicated in the amendment filed December 21, 2005 that claims 51-114 had been copied, or substantially copied, from various patents for the purposes of provoking interference. For reasons unrelated to the merits, applicant has decided against pursuing an interference at this time and has canceled claims 51-114.

### **II. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 44-53, 57-60, 62, 66-69, 71, 72, 74, 75, 77-80, 84, 86-89, 93-97, 99-102, 106 and 108-111 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,263,493 to Avitall ("the Avitall '493 patent"). Claims 54-56, 61, 63-65, 70, 81-83, 85, 90-92, 103-105, 107 and 112-114 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Avitall '493 patent and U.S. Patent No. 5,500,012 to Brucker. Claims 73, 76 and 98 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Avitall '493 patent and U.S. Patent No. 5,411,025 to Webster.

As claims 45 and 51-114 have been canceled, it is respectfully submitted that the rejections thereof under 35 U.S.C. §§ 102 and 103 have been rendered moot. The rejection of the remaining claims under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

**B. Discussion Concerning Claims 44 and 46-50**

Independent claim 44 calls for an ablation device comprising “a member defining an expanded size and shape that corresponds to a circumferential region of tissue associated with an orifice of a vein that carries blood to an atrium” and “an ablation element associated with the member and adapted to form a lesion in a substantial portion of the circumferential region of tissue associated with an orifice of a vein that carries blood to an atrium.” The respective combinations defined by claims 46-50 include, *inter alia*, the elements recited in claim 44.

The Avitall ‘493 patent fails to teach or suggest the claimed combinations. For example, the Avitall loop structures have expanded sizes and shapes that correspond to the tricuspid annulus, not to an orifice of a vein that carries blood to an atrium. [See, e.g., column 3, lines 5-7, 20-25, 39-40 and 53-56; column 4, lines 21-25; column 5, lines 14-16; and column 7, lines 17-40.] The Office Action has not shown that a size and shape that corresponds to the tricuspid annulus also “corresponds to a circumferential region of tissue associated with an orifice of a vein that carries blood to an atrium.”

The Avitall ‘493 patent does state that the loop structures disclosed therein can be used to map and ablate “heart chambers” and that the loop structure illustrated in Figure 6A “is suitable for mapping other cardiac areas.” [Column 1, lines 21-25; and column 3, lines 44-45.] Applicant respectfully submits that such vague language is insufficient to anticipate, or even render obvious, the specific language set forth in claim 44.

As the Avitall ‘493 patent fails to teach or suggest each and every element of the combination recited in independent claim 44, applicant respectfully submits that claims 44 and 46-50 are patentable thereover and that the rejection under 35 U.S.C. § 102 should be withdrawn.

### **III. NEWLY PRESENTED CLAIMS 148-154**

Newly presented independent claim 148 is directed to a catheter that comprises "a catheter body" and "means, associated with the catheter body, for forming a lesion in at least a substantial portion of a circumferential region of tissue associated with an orifice of a vein that carries blood to an atrium." Applicant respectfully submits that the cited references fail to teach or suggest, for example, structure that performs the function set forth in the means-plus-function element and that claims 148 and 149 are patentable thereover.

Newly presented independent claim 150 is directed to a catheter that comprises "a catheter body including at least one energy transmission line" and "means, operably connected to the at least one energy transmission line, for simultaneously coupling a continuous circumferential region of tissue that surrounds an orifice of a vein that carries blood to an atrium to energy from the at least one energy transmission line." Applicant respectfully submits that the cited references fail to teach or suggest, for example, structure that performs the function set forth in the means-plus-function element and that claims 150-152 are patentable thereover.

Newly presented independent claim 153 is directed to a catheter that comprises "a catheter body" and "means, associated with the catheter body, for expanding within an atrium, contacting a circumferential region of tissue that surrounds an orifice of a vein that carries blood to the atrium, and forming a continuous lesion in the circumferential region of tissue." Applicant respectfully submits that the cited references fail to teach or suggest, for example, structure that performs the function set forth in the means-plus-function element and that claims 153 and 154 are patentable thereover.

### **IV. CLOSING REMARKS**

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the

application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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Date

/Craig A. Slavin/

Craig A. Slavin

Reg. No. 35,362

Attorney for Applicant

**Henricks, Slavin & Holmes LLP**

840 Apollo Street, Suite 200

El Segundo, CA 90245

(310) 563-1458

(310) 563-1460 (Facsimile)